

REMARKS

Claims 1-33 were previously pending, of which claims 2, 9, 29, and 32 have been canceled; therefore, claims 1, 3-8, 10-28, 30-31, and 33 are currently pending. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Claim Objections

Claim 15 stands objected to as being dependent upon itself. In response, Applicants have amended claim 15 to depend from claim 8, thereby rendering the subject objection moot.

Rejections under 35 U.S.C. §101 and 35 U.S.C. §112

Claims 8-27 and 31-33 stand rejected under 35 U.S.C. §101 and 35 U.S.C. §112 as being unsupported by either a specific asserted utility or a well-established utility. In response, Applicants have amended the claims overcome the subject rejections and therefore respectfully request that the rejections be withdrawn.

Rejections under 35 U.S.C. §103

Claims 1-13 and 23-33 stand rejected under 35 U.S.C. §103 as being anticipated by U.S. Patent No. 6,414,950 to Rai et al. ("Rai") in view of U.S. Patent No. 6,553,015 to Sato ("Sato"). Claims 14-22 stand rejected under 35 U.S.C. §103 as being unpatentable over Rai in view of Sato and further in view of U.S. Patent No. 6,252,851 Siu et al. ("Siu"). Applicants traverse these rejections on the grounds that the above references are defective in establishing a prima facie case of obviousness with respect to all these claims.

As provided in MPEP §2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP §2142,

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

It is submitted that, in the present case, the Examiner cannot factually support a prima facie case of obviousness for the following, mutually exclusive, reasons.

In general, Applicants resubmit that the Examiner has failed to "bear the initial burden of factually supporting [a] prima facie conclusion of obviousness" for the reasons set forth in detail in Applicants' response to the November 20, 2006, Office action. The Examiner failed to respond to the Applicants'

position in the present Office action, either by rebutting Applicants' statements or by appropriately revising the reasons in support of the Examiner's position in the present Office action; rather, the reasons set forth in the present office action are almost identical, but for the addition of two sentences, discussed below, to the reasons set forth in the November 20th Office action.

Notably, as pointed out by Applicants in the response to the November 20th Office action, the discussion of the Sato reference points to "Col. 20, lines 4 plus" of that reference; however, Sato contains only 12 columns. Hence, it is unclear what particular text of Sato the Examiner contends supports his arguments for non-patentability of the claims. The Examiner then goes on to cite a reference (referred to by the Examiner as "a Fast Mobile IP") that was neither provided to nor cited by Applicants as teaching reduction of packet loss "*by buffering and forwarding packets* for the mobile terminal between the access router currently connecting to the mobile terminal and a destination access router" (emphasis original). This citation renders the Examiner's position with regard to patentability of the cited claims even less clear than before. If it is the Examiner's position that the combination of Rai, Sato, and a Fast Mobile IP renders the claims obvious, the Examiner should so state and provide a copy of a Fast Mobile IP to Applicants; otherwise, the citation to the reference is misplaced.

In view of the foregoing, as previously noted, Applicants are left to piece together the Examiner's argument based on a general explanation of the references and how the references are combined to read on Applicants claimed. As a result, the Examiner's argument is so general as to fail to meet the burden placed upon him by the MPEP, as cited above.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

Claim 1, as amended, recites:

upon initiation of the handoff, sending a first message to the first agent requesting the first agent to buffer at the first agent all packets being sent to the mobile node, wherein the first message is part of a registration request protocol to the second agent;

and

responsive to the completing, sending a second message to the first agent requesting the first agent to forward the packets buffered at the first agent to the second agent, wherein the second message is also a part of the registration request protocol.

With regard to Rai, the Examiner cites column 46, lines 64 *et seq.*, which discloses that, "the old wireless hub can forward buffered packets to the new wireless hub upon hearing a TearXTunnel message from the serving IWF" (emphasis added). Using the Examiner's logic, the TearXTunnel message is the

“second message” recited in claim 1; however, claim 1 further requires that the second message is part of the registration request protocol, which the TearXTunnel message of Rai clearly is not. Sato fails to remedy the deficiencies of Rai in this regard and the Examiner has provided no evidence to the contrary in this regard. In particular, as noted above and as noted in responses to previous Office actions, the portion of Sato cited by the Examiner (i.e., column 20, lines 4 *et seq.*) do not exist, as the Sato patent includes only 12 columns.

Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a prima facie case of obviousness clearly cannot be met, and any rejection of claim 1 under 35 U.S.C. §103 should be withdrawn. Claims 3-6 depend from and further limit claim 1 and are therefore also deemed to be in condition for allowance for at least the same reasons as claim 1.

Claims 7, 8, 23, 28, and 31 include limitations similar to those of claim 1 and are therefore also allowable for at least the same reasons as claim 1. Claims 10-22, 24-27, 30, and 33 depend from and further limit claims 7, 8, 23, and 31 and are therefore also deemed to be in condition for allowance for at least that reason.

2. The Combination of References is Improper

There is still another, mutually exclusive, and compelling reason why the Rai and Sato patents cannot be applied to reject the claims under 35 U.S.C. §103.

§2142 of the MPEP also provides

[T]he examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole.’

In the present case, neither Rai or Sato teaches, or even suggests, the desirability of the combination of claim 1, for at least the reasons set forth above. Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of claim 1.

In this context, the MPEP further provides at §2143.01

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Recently, the Supreme Court ruled that the longstanding “teaching, suggestion, or motivation (TSM) test” still applies, but should be used in a more “expansive and flexible” manner. *KSR Int’l. Co. v.*

Teleflex Inc., 550 U.S. ___, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15 (emphasis added).

In the present case, the Examiner has not expressed any valid reason why a person of ordinary skill in art would have combined Rai's teaching of sending of buffered data from a first agent of a first wireless hub to a second agent of a second wireless hub with Sato's teaching of a completely different mobile communications buffering system, one in which a mobile node, and not an agent of a wireless hub, performs the buffering and the subsequent sending of buffered data. Sato's algorithm used to provide buffer management for a system that buffers data in the mobile node could not be applied to, nor combined with, Rai's mobile communication system that teaches the buffering of data in an agent of a wireless hub, and not in the mobile node, as the problems encountered by each of the systems are different than those of the other one of the systems. Sato's algorithm is not compatible with the system as taught in Rai. If Sato's algorithm were to be applied to the system taught in Rai, the intended purposes of both Rai and Sato would be destroyed. Notably, this argument, which was also made by Applicants' in response to the Office actions mailed March 29, 2004, and November 20, 2006, has not been addressed by the Examiner in any subsequent Office action.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In view of the foregoing, it is apparent that none of the cited references provides any incentive or motivation supporting the desirability of the combination. Therefore for this mutually exclusive reason, the Examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met, and the rejection under 35 U.S.C. §103 is not applicable to the pending claims.

Conclusion

It is clear from the foregoing that independent claims 1, 7, 8, 23, 28, and 31 are in condition for allowance. Claims 3-6, 10-22, 24-27, 30, and 33 depend from and further limit independent claims 1, 7, 8, 23, and 31, and are therefore also deemed to be in condition for allowance.

An early formal notice of allowance of all pending claims is requested.

Respectfully submitted,



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